

### **REMARKS**

We affirm the provisional election made, with traverse, by Kevin Hooper on February 14, 2006 to prosecute the invention of Group I (*i.e.*, claims 1-18 and 23).

#### **Rejection under 35 U.S.C. § 103**

Claims 1-8, 13-18, and 23 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Krishnan *et al.*, WO 95/24447 ("Krishnan"). (Paper No. 0206 at 5). For the reasons set forth below, the rejection is respectfully traversed.

Krishnan discloses compatibilized blends of biodegradable hydrophobic polyester, unmodified starch or other similar polysaccharide, other biodegradable polymers, plasticizers, and additives. (Abstract). These blends are produced in the absence of water. The presence of water is considered detrimental by Krishnan because the effect of the reduced melt elongation and strength is greater than the enhancement of the interfacial adhesion that the presence of water could promote (page 18, lines 1-9): "The presence of water is deleterious ... in melt elongation and strength."

In making the rejection, the Examiner asserted that in Krishnan "[t]he polymer forms a continuous phase while starch forms a discontinuous one. A preferred biodegradable polymer is poly (E-caprolactone) (p. 7 line 20). Organic plasticizers, such as esters are included in the blend (p. 15, lines 21-30). Compatibilizers are also used (p. 13, lines 18-35). Also included in the blend may be certain additives that function as binders by complexing with starch (p. 19, lines 10-16). They include monoglycerides." (Paper No. 0206 at 5).

The Examiner acknowledged, however, that "Krishnan [ ] do[es] not specifically mention the (claimed) dissociation constant pK as lower than 4.5" and "Krishnan [ ] do[es] not disclose the specific hydrophilic lipophilic balance index value (HLB) of the ester." (*Id.* at 6).

To fill this acknowledged gap, the Examiner asserted that "the instant Specification discloses the use of esters of acetic acids as usable therein at the paragraph bridging pages 5 and 6, which are identical to those disclosed [in Krishnan] at page 15 (lines 21 -30)" and "since [Krishnan] broadly teaches the (claimed) glycerides, it is reasonable to assume that the glycerides of Krishnan [ ] possess th[ese] properties," and "[t]herefore it would have been obvious to follow [the] teachings of Krishnan [ ] and arrive at the instant invention." (*Id.*). "Since no criticality has been established for claimed pK to be lower than 4.5 and HLB to be greater than 8, the instant claims are deemed to be *prima facie* obvious over Krishnan." (*Id.*).

The Examiner further asserted that "the paragraph bridging page 5 to page 6 of the instant Specification teaches the employment of esters of glycerol with acetates" and "[t]he fact that one inventor characterizes a constituent in a way that differs from applicant's method of characterization is not sufficient to remove the grounds of rejection. The inclusion of the constituent is sufficient." (*Id.* at 10-11).

Initially, we note that the Examiner bears the burden of setting forth a *prima facie* case of unpatentability. *In re Glaug*, 62 USPQ2d 1151, 1152 (Fed. Cir. 2002); *In re Oetiker*, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992); and *In re Piasecki*, 223 USPQ 785, 788 (Fed. Cir. 1984). If the PTO fails to meet its burden, then the applicant is entitled to a patent. *Glaug*, 62 USPQ2d at 1152. Furthermore, "[t]o

establish prima facie obviousness of a claimed invention, all claim limitations must be taught or suggested by the prior art.” MPEP § 2143.03, citing *In re Royka*, 180 USPQ 580 (CCPA 1974).

Claim 1 (from which claims 2-8, 13-18, and 23, either directly or indirectly depend) recites “an interfacial agent,” which is an ester having an HLB greater than 8, which ester is obtained from (1) a polyol, (2) a monocarboxylic acid, or (3) a polycarboxylic acid, each of which have a pK lower than 4.5.

It is respectfully submitted that Krishnan does not disclose or suggest the interfacial agents of the **claimed** invention. The Examiner refers to “organic plasticizers” cited by Krishnan, which include glycerol monoacetate, diacetate, and triacetate. (See page 15, lines 21-30). Because acetic acid has a pK higher than 4.5 (namely 4.75), the glycerol esters identified by the Examiner are outside the scope of claim 1. Also, the binders to which the Examiner refers, cited on page 19, lines 10-16 of Krishnan, include glycerol monostearate and glycerol monopalmitate, which have a HLB of about 3.8 (see Exhibit 1 of our August 22, 2005 Response), and are, therefore, lower than the minimum value (“HLB greater than 8”) required by the presently claimed invention. Furthermore, stearic acid and palmitic acid are weak acids having a pK higher than 4.5. Such binders do not fall within the scope of the claimed invention and, accordingly, do not suggest the specific interfacial agent of the claimed invention. For this reason alone, it is respectfully submitted that rejection should be withdrawn.

It is axiomatic that it is the scope of the **claimed** invention that must be examined to establish obviousness. We respectfully note, however, that the Examiner’s assertion that the acetic acid esters cited “at the paragraph bridging pages 5 and 6” in

the specification (*i.e.*, mono-, di-, and tri- chloroacetic acids) are "identical to those disclosed" in Krishnan at page 15, lines 21-30 (*i.e.*, glycerol mono-, di-, and tri-acetates) is **not** correct. The esters cited "at the paragraph bridging pages 5 and 6" of the instant specification are mono-, di- and tri- chloroacetic acids. These acids are different from acetic acid because of their very low pK values, which are characteristic of strong acids. Mono-, di-, and tri- chloroacetic acids have a pK value of 2.83, 1.48, and 0.7, respectively, which is **far lower** than the pK value of acetic acid (4.75), which is considered a weak acid. Also, the pK of 4.75 is outside the range required by the presently claimed invention.

Therefore, the Examiner's further assertion that "the paragraph bridging page 5 to page 6 of the instant Specification teaches the employment of esters of glycerol with acetates" and the Examiner's rationale that "[t]he fact that one inventor characterizes a constituent in a way that differs from applicant's method of characterization is not sufficient to remove the grounds of rejection" is flawed. (Paper No. 0206 at 10-11). The paragraph bridging page 5 to 6 of the present application refers to esters of specific acids, which **all** have a pK lower than 4.5 as required by the claimed invention.

In contrast, Krishnan on page 15, line 27 generically refers to "glycerol esters," which are identified as including glycerol monoacetate, diacetate, and triacetate (page 15, lines 28-30). As discussed above, these cited glycerol esters are outside the scope of claim 1. And, the generic disclosure of "glycerol esters" simply does not disclose or suggest what is claimed: an ester having an hydrophilic/lipophilic balance index value (HLB) greater than 8, which ester is obtained from a polyol or a mono- or

polycarboxylic acid having a dissociation constant pK lower than 4.5, wherein the pK value refers to the first carboxyl group of the polycarboxylic acid. As is well settled, a broad genus does not *per se* render obvious a species or subgenus contained therein. See, e.g., *In re Baird*, 29 USPQ2d 1550, 1552 (Fed. Cir. 1994); see also MPEP § 2144.08 (8<sup>th</sup> Ed., Rev. 3, Aug. 2005, p. 2100-154). To support a *prima facie* case of obviousness, a cited document must provide motivation for one of ordinary skill in the art to select the claimed species or subgenus and arrive at the claimed invention. See MPEP § 2144.08 (p. 2100-154).<sup>1</sup>

Krishnan also discloses the use of decaglycerol tetraoleate as a stretching agent, which improves the tensile elongation of the blend materials. (See page 19, lines 23-35). Decaglycerol tetraoleate has a HLB of 6.2 and is also outside the scope of the claimed interfacial agents. (See Exhibit 2 of our August 22, 2005 Response). According to Krishnan, compositions without decaglycerol tetraoleate are brittle and have a poor elongation at break. (See page 19, lines 28-29).

Therefore, Krishnan not only fails to disclose or suggest the dissociation constant pK and the HLB value for the claimed interfacial agents, but also fails to disclose or suggest interfacial agents exhibiting properties of the claimed compositions (*i.e.*, capable of maintaining high mechanical properties under conditions of low humidity). For this additional reason, it is respectfully submitted that the rejection should be withdrawn.

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<sup>1</sup> “Office personnel should determine whether one of ordinary skill in the relevant art would have been motivated to make the claimed invention as a whole, *i.e.* to select the claimed species or subgenus from the disclosed prior art genus. See *Deuel*, 51 F.3d at 1557, 34 USPQ2d at 1214 (“[A] *prima facie* case of unpatentability requires that the teachings of the prior art suggest *the claimed compounds* to a person of ordinary skill in the art.” (emphasis in original)).”

The interfacial agents according to the claimed invention are ***specifically designed*** to achieve compositions having a fine microstructure of starch, with a size of the dispersed starch particles less than 1  $\mu\text{m}$  for more than 80%. (See page 7, lines 7-16). The microstructure allows the production of films, which still retain good tensile and tear strength properties after washing with water. (See page 7, last full paragraph). Thus, contrary to the Examiner's assertion regarding criticality (see Paper No. 0206 at 6), the application ***clearly identifies*** the need for the pK and HLB parameters recited in the claims.

Even with the use of decaglycerol tetraoleate, the blends disclosed by Krishnan do not achieve the fine microdispersion of starch achieved by the claimed invention. For example, Example 2 of Krishnan discloses use of decaglycerol tetraoleate. The structure of the resulting blend is shown in Figure 1. In Figure 1, starch particles are visible and have a size of about 10  $\mu\text{m}$ . (See page 22, Example 2 and Figure 1).

This is because Krishnan is based on principles, which are quite different from that of the claimed invention. Krishnan requires the use of decaglycerol tetraoleate and also the use of a starch, which has been pre-dried, before being blended, to a moisture content of less than 1% by weight and preferably between 0.5% and 1.0% by weight. In Krishnan, the presence of water in greater amounts is considered detrimental, because the effect of the reduced melt elongation and strength is greater than the enhancement of the interfacial adhesion that the presence of water could promote. (See page 18, lines 1-9). By contrast, the esters recited in claim 1 are water soluble (see, e.g., Specification at p. 5).

Thus, the Krishnan compositions are non-analogous to the presently recited compositions, and there is no teaching or suggestion in Krishnan leading to the presently claimed compositions. Accordingly, for this further reason, it is respectfully submitted that the rejection should be withdrawn.

We further note that the rejection treats all the claims as standing or falling with claim 1. The rejection, however fails to account for the further elements recited in the dependent claims. For example, the Examiner failed to make any factual determinations regarding whether the thermoplastic polymer is obtained by one of the reactions recited in claim 14. It is axiomatic, however, that a dependent claim is not *per se* obvious by a document that allegedly renders obvious the base claim. Accordingly, "[e]xaminers are reminded that a dependent claim is directed to a combination including everything recited in the base claim and what is recited in the dependent claim. ***It is this combination that must be compared with the prior art, exactly as if it were presented as one independent claim.***" MPEP § 608.01(n) (8<sup>th</sup> ed. Rev. 3, Aug. 2005, pp. 600-88). This the Examiner has not done. For this additional reason, the rejection of claims 2-8, 13-18, and 23 is insufficient as a matter of law and should be withdrawn.

#### **Rejections under 35 U.S.C. § 102**

Claims 1-18 and 23 were rejected under 35 USC § 102(b) as anticipated by Bastioli *et al.*, WO 94/03543 ("Bastioli I") and under 35 USC § 102(e) as anticipated

by Bastioli *et al.*, U.S. Patent No. 5,874,486 ("Bastioli II").<sup>2</sup> (Paper No. 0206 at 7-8).

For the reasons set forth below, the rejections are respectfully traversed.

Bastioli I & II disclose "[a] polymeric composition compris[ing] a matrix including a starch component and at least one synthetic thermoplastics polymeric component in which a filler is dispersed, characterised in that the matrix includes a fluidising agent selected from the group consisting of C<sub>12</sub>-C<sub>22</sub> fatty acids, C<sub>12</sub>-C<sub>22</sub> fatty alcohols, esters and amides of the said fatty acids, poly and polyglycol ethers of alditols or polyglycerols esterified with the said fatty acids and their mixtures ...." (Abstract). "The fluidising agents previously mentioned are particularly useful for the production of compositions with a high filler content." (Page 9, lines 2-44; Col. 4, lines 8-10). "These agents include fatty acids such as oleic, palmitic, stearic, linoleic, linolenic, recinoleic, erucic acids, the corresponding fatty alcohols or esters or amides of the fatty acids listed above, in particular, mono-, di-, or tri-glycerides of the said fatty acids." (Page 9, lines 5-9; Col. 4, lines 11-15).

In making the rejection, with regard to Bastioli I, the Examiner asserted **only** that "[t]he patent ... shows the contemplated invention at the Abstract and the claims," and with regard to Bastioli II, the Examiner instructed only: "[n]ote the claims and column 4 (lines 11 -23)." (Paper No. 0206 at 7-8).

Initially, we note, as is well settled, anticipation requires "identity of invention." *Glaverbel Societe Anonyme v. Northlake Mktg. & Supply*, 33 USPQ2d 1496, 1498 (Fed. Cir. 1995). Each and every element recited in a claim must be found in a

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<sup>2</sup> We note for the record that Bastioli II is the national stage application of Bastioli I and appears to have the same specification as Bastioli I.



single prior art reference and arranged as in the claim. *In re Marshall*, 198 USPQ 344, 346 (CCPA 1978); *Lindemann Maschinenfabrik GMBH v. American Hoist and Derrick Co.*, 221 USPQ 481, 485 (Fed. Cir 1984). "Moreover, it is incumbent upon the Examiner to **identify where each and every facet** of the claimed invention is disclosed in the applied reference." *Ex parte Levy*, 17 USPQ2d 1461, 1462 (BPAI 1990). The Examiner is required to point to the disclosure in the reference "**by page and line**" upon which the claim allegedly reads. *Chiong v. Roland*, 17 USPQ2d 1541, 1543 (BPAI 1990).

This the Examiner has not done. It is the claims that define what the applicant regards as the invention and **it is the claims which are examined and rejected**, if appropriate. See 37 CFR § 1.104(c). In the Office Action, the Examiner asserted, with regard to Bastioli I, **only** that "[t]he patent ... shows the contemplated invention at the Abstract and the claims," and with regard to Bastioli II, the Examiner asserted **only** to "[n]ote the claims and column 4 (lines 11 -23)." This, however, is not the stuff of a §102 rejection.

Having failed to address each and every element of claims 1-18 and 23, the Examiner failed to identify where in Bastioli I and II each and every element of the claims are shown. That, however, was the Examiner's burden. Accordingly, the rejections are insufficient as a matter of law and fact to support a conclusion of anticipation, and for this reason alone, the rejections should be withdrawn.

With a view towards furthering prosecution, we address the merits of the rejections to the extent we understand them. Initially we note that the fluidising agents disclosed in Bastioli I and II are esters of fatty acids with a HLB value that is **lower** than

5.5. It is respectfully submitted that these are a different class of esters than the esters of the presently claimed invention (*i.e.*, "an ester having an hydrophilic/lipophilic balance index value (HLB) *greater than 8*, which ester is obtained from a polyol or a mono- or polycarboxylic acid having a dissociation constant pK lower than 4.5, wherein the pK value refers to the first carboxyl group of the polycarboxylic acid"). As disclosed above, one skilled in the art knows that fatty acid glycerol esters, such as glycerol monostearate and glycerol monopalmitate have a HLB value of about 3.8. (*Supra* at 9). It is also well known that the polyol acetates used as plasticizers in the Bastioli references are esters of an acid having a pK higher than the instantly claimed limit of 4.5 (see, *e.g.*, Claim 12 of Bastioli II: "sorbitol ethoxylate, glycerol ethoxylate, pentaerythritol ethoxylate, sorbitol acetate, and pentaerythritol acetate").

Thus, it is respectfully submitted that the rejection does not - and cannot - demonstrate that Bastioli I and II disclose what is claimed. Nor does the rejection identify any evidence from either Bastioli I and II that discloses "an ester having an hydrophilic/lipophilic balance index value (HLB) greater than 8, which ester is obtained from a polyol or a mono- or polycarboxylic acid having a dissociation constant pK lower than 4.5, wherein the pK value refers to the first carboxyl group of the polycarboxylic acid" as claimed. Accordingly, it is respectfully submitted that the rejections are insufficient as a matter of fact and should be withdrawn.

Both rejections are also devoid of any discussion of dependent claims 2-18 and 23. Accordingly, the record is devoid of any evidence that the Examiner individually considered claims 2-18 and 23. It is axiomatic, however, that a dependent claim is not *per se* anticipated by a reference that allegedly anticipates the base claim.

Accordingly, "[e]xaminers are reminded that a dependent claim is directed to a combination including everything recited in the base claim and what is recited in the dependent claim. ***It is this combination that must be compared with the prior art, exactly as if it were presented as one independent claim.***" MPEP § 608.01(n) (8<sup>th</sup> ed. Rev. 3, Aug. 2005, pp. 600-88). This the Examiner has not done. Accordingly, for this additional reason, the rejections are both factually and legally deficient as to claims 2-18 and 23. And for this additional reason, the rejections should be withdrawn as to claims 2-18 and 23.

#### **Obviousness-type Double Patenting Rejections**

Claims 1-18 and 23 were rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-17 of U.S. Patent No. 6,348,524. (Paper No. 0206 at 9).

The Examiner asserted "[a]lthough the conflicting claims are not identical, they are not patentably distinct from each other because the term plasticizer, recited in the patented claims, would embrace the constituents recited herein as an interfacial agent." (*Id.*).

Claims 1-18 and 23 were also provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-17 of U.S. Patent Application Serial No. 09/335,238. (Paper No. 0206 at 9).

The Examiner asserted that "[a]lthough the conflicting claims are not identical, they are not patentably distinct from each other because the term plasticizer, recited in the copending application claims, would embrace the constituents recited

herein as an interfacial agent.” (*Id.*). “This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.” (*Id.*).

We note U.S. Application Serial No. 09/335,238 is the patent application that ultimately became U.S. Patent No. 6,348,524 referenced above. Therefore, U.S. Application Serial No. 09/335,238 and U.S. Patent No. 6,348,524 are one and the same. Accordingly, the second provisional double patenting rejection is duplicative.

With a view toward furthering prosecution and without acquiescing to the merits of the rejection, should the obviousness-type double patenting rejection over U.S. Patent No. 6,348,524, formerly U.S. Application Serial No. 09/335,238, be the only rejection remaining, a terminal disclaimer will be tendered.

Claims 1-18 and 23 were also rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-19 of U.S. Patent No. 5,874,486. (Paper No. 0206 at 9).

In making this rejection, the Examiner asserted that “[a]lthough the conflicting claims are not identical, they are not patentably distinct from each other because the inclusion of a composition of a dispersed starch in a continuous polymer phase is within the recitations of the patented claims. Further, the specific fluidizing (interfacial) agents recited in the patented claims embrace those esters as recited and claimed herein. The agents may have the identical physical characteristics recited herein. **Note column 4 (lines 11 -23) which teaches the identical esters as employed herein.**” (*Id.*) (emphasis added).

Claims 1-18 and 23 were also rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-10 of U.S. Patent No. 6,277,899. (Paper No. 0206 at 10).

In making the rejection, the Examiner asserted that "[a]lthough the conflicting claims are not identical, they are not patentably distinct from each other because the inclusion of a composition of a dispersed starch in a continuous polymer phase is within the recitations of the patented claims. Further, the specific fluidizing (interfacial) agents recited in the patented claims embrace those esters as recited and claimed herein. The agents may have the identical physical characteristics recited herein. **Note the paragraph bridging column 3 to column 4 which teaches the identical esters as employed herein.**" (*Id.*) (emphasis added).

With respect to the rejection over U.S. Patent No. 5,874,486, we note independent claim 1, the only independent claim, of the '486 Patent recites:

A polymeric composition obtained by melt-dispersing a natural filler of an organic nature in a matrix extruded from a preliminary composition comprising:

- (a) a starch component;
  - (b) a synthetic thermoplastic polymeric component; and
  - (c) a fluidizing agent selected from the group consisting of C<sub>12</sub>-C<sub>22</sub>, fatty acids, C<sub>12</sub>-C<sub>22</sub> fatty alcohols, **esters and amides of said fatty acids**, polyolefin waxes, polyglycol ethers of alditols, **polyglycerols esterified with C<sub>12</sub>-C<sub>22</sub> fatty acids**, and mixtures thereof,
- wherein the filler is dispersed in the matrix in an amount of from 5% to 70% by weight with respect to the total weight of the polymeric composition, and the matrix in which the filler is dispersed has a water content of less than 6% by weight.

With respect to the rejection over U.S. Patent No. 6,277,899, we note independent claim 1, the only independent claim, of the '899 Patent recites:

A polymeric composition comprising a filler melt-dispersed in a matrix comprising:

- (a) a destructureized starch component;
  - (b) a synthetic thermoplastic polymeric component selected from the group consisting of polyvinylalcohol, polyvinyl acetate, thermoplastic polyesters and graft copolymers of polysaccharides; and
  - (c) a fluidizing agent selected from the group consisting of C<sub>12</sub>-C<sub>22</sub> fatty acids, C<sub>12</sub>-C<sub>22</sub> fatty alcohols, **esters and amides of said fatty acids**, polyolefin waxes, polyglycol ethers of alditols, **polyglycerols esterified with C<sub>12</sub>-C<sub>22</sub> fatty acids**, and mixtures thereof,
- wherein said filler is a mixture of an inorganic filler and a filler of organic nature, wherein the organic filler is present in an amount from 5% to 70% by weight.

Here, in contrast, claim 1 recites:

A biodegradable heterophase polymeric composition having good resistance to ageing and to low humidity conditions, the composition comprising  
a thermoplastic starch  
a thermoplastic polymer incompatible with starch, wherein the starch is in a dispersed phase and the thermoplastic polymer is in a continuous phase, and  
an interfacial agent which is **an ester having an hydrophilic/lipophilic balance index value (HLB) greater than 8, which ester is obtained from a polyol or a mono- or polycarboxylic acid having a dissociation constant pK lower than 4.5**, wherein the pK value refers to the first carboxyl group of the polycarboxylic acid.

The burden in an obviousness-type double patenting rejection is not easy to meet because such a rejection requires (1) that the Examiner first determine whether to apply a one-way test or a two-way test, and then (2) that the Examiner apply the test selected. *In re Braat*, 19 USPQ2d 1289, 1292 (Fed. Cir. 1991) ("We note at the outset the difficulty which arises in all obviousness-type double patenting cases of determining when a claim is or is not an obvious variation of **another claim**." (emphasis in original)).

While the specification may be used for learning the meaning of terms in a claim, resort to a patent's specification may *never* be had to read limitations into a claim and thereby change the scope of an asserted claim.

As Judge Rich explained in *General Foods Corp. v. Studiengesellschaft Kohle mbH*, 972 F.2d 1272, 1281-82, 23 USPQ2d 1839, 1843 (Fed. Cir. 1992), well settled precedents "**prohibit**" the use of the disclosure of a patent cited to support alleged double patenting.<sup>3</sup> Here, the Examiner does exactly that by relying on "column 4 (lines 11 -23)" of the '486 patent and "the paragraph bridging column 3 to column 4" of the '899 patent to support the double patenting rejections. (Office Action dated 02/16/06 at 9-10).

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**Precedents Prohibit Use of Disclosure of Patent Cited to Support Double Patenting:**

Our precedent makes clear that the **disclosure** of a patent cited in support of a double patenting rejection cannot be used as though it were prior art, **even where the disclosure is found in the claims**. See, e.g., *Braat*, 937 F.2d at 594 n. 5, 19 USPQ2d at 1293 n. 5 ("The patent disclosure must not be used as prior art"); *Vogel*, 422 F.2d at 442, 164 USPQ at 622 (in considering obviousness-type double patenting, "the patent disclosure may not be used as prior art"); *In re Plank*, 399 F.2d 241, 242, 158 USPQ 328, 329 (CCPA 1968) ("Its claims [Plank *et al.* patent] are used as the basis for a double patenting rejection. It is not a prior art reference"); *In re Aldrich*, 398 F.2d 855, 859, 158 USPQ 311, 314 (CCPA 1968) ("double patenting rejections **cannot** be based on section 103, ... or on the disclosures of the patents whose claims are relied on to demonstrate double patenting or on the 'disclosures' of their claims... [P]atent claims are looked to only to see what **has been patented**, the subject matter which **has been protected**, not for something one may find to be disclosed by reading them"); *In re Boylan*, 392 F.2d 1017, 1018 n.1, 157 USPQ 370, 371 n. 1 (CCPA 1968) ("in analyzing cases of these types, it must always be carefully observed that the appellant's patent is not 'prior art' under either section 102 or section 103 of the 1952 Patent Act"); *In re Braithwaite*, 379 F.2d 594, 600 n. 4, 154 USPQ 29, 34 n. 4 (CCPA 1967) ("While analogous to the non-obviousness requirement of 35 U.S.C. § 103, that section is not itself involved in double patenting rejections because the patent principally underlying the rejections is not prior art"); *Borah*, 354 F.2d at 1018, 148 USPQ at 221 ("We have no prior art here"); *In re Sutherland*, 347 F.2d 1009, 1015, 146 USPQ 485, 491 (CCPA 1965) ("Nor is obviousness invariably involved in 'double patenting' rejections. Claims relied on in such [double patenting] rejections often disclose or name the **very thing** being claimed [in the rejected claims]. Furthermore, the words of such claims cannot be treated as 'prior art,'...but are looked to solely for the purpose of determining **what has already been patented**. They are not treated as prior art for the simple reason they are no more 'prior art' under the statute than the specification") (citation omitted); *In re Sarett*, 327 F.2d 1005, 1013, 140 USPQ 474, 481 (CCPA 1964) ("We are not here concerned with what one skilled in the art would be aware [of] from **reading** the claims but **what inventions the claims define**.").

The Examiner then goes on to **wrongly** characterize those passages by asserting that they "teach[ ] the **identical esters** as employed" by the presently claimed invention. (*Id.*). However, the fluidizing agents recited in these two patents, and **in the claims** of these two patents, do not embrace the esters recited in the present claims. The esters of the fatty acids in these patents have a HLB lower than 5.5, which is outside of the scope of the present claims.

Therefore, the rejection fails to disclose **where in claims 1-19** of U.S. Patent No. 5,874,486 and **claims 1-10** of U.S. Patent No. 6,277,899 there is a suggestion or motivation for "an interfacial agent which is an ester having an hydrophilic/lipophilic balance index value (HLB) greater than 8, which ester is obtained from a polyol or a mono- or polycarboxylic acid having a dissociation constant pK lower than 4.5, wherein the pK value refers to the first carboxyl group of the polycarboxylic acid" as recited in claim 1.

In view of remarks set forth above, it is respectfully submitted that the obviousness-type double patenting rejections of claims 1-18 and 23 over claims 1-19 of U.S. Patent No. 5,874,486 and claims 1-10 of U.S. Patent No. 6,277,899 cannot stand and should be withdrawn.



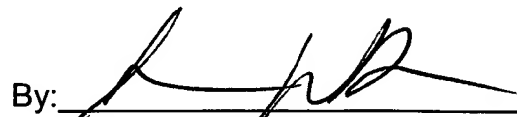
Application No.: 09/297,733  
Amendment Dated: May 16, 2006  
Reply to Office Action Dated: February 16, 2006

For the reasons set forth above, withdrawal of the rejections and allowance of all claims are respectfully requested. If the Examiner has any questions regarding this paper, please contact the undersigned.

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Mail Stop Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on May 16, 2006.

  
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Respectfully submitted,

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